REMARKS

Reconsideration of the application is respectfully requested in view of the above amendments and the following remarks. Claims 1-48 were pending in the present application. Claims 1-48 are subject to a restriction requirement. Claims 41-48 have been canceled. Claims 1-40 are currently pending.

Claims 41-48 have been canceled without prejudice to filing a divisional application directed to the subject matter claimed therein.

No new matter has been added to the above-captioned application by the amendments.

RESTRICTION REQUIREMENT UNDER 35 U.S.C. 121

The Examiner has stated that Claims 1-48 are generic to a plurality of disclosed patentably distinct species comprising a pharmaceutical composition comprising:

Group 1: two appetite suppressants, or

Group 2: an appetite suppressant and a metabolic rate enhancer, or,

Group 3: an appetite suppressant and a nutrient absorption inhibitor, or,

Group 4: two metabolic rate enhancers, or,

Group 5: a metabolic rate enhancer and a nutrient absorption inhibitor, or

Group 6: two nutrient absorption inhibitors

to treat a disorder associated with excessive food intake.

Applicants hereby provisionally elect to prosecute the invention and claims of Group 1, directed to compositions of two appetite suppressants, with traverse.

For proper restriction, two criteria must be met: (1) the inventions must be independent or distinct as claimed; and (2) there must be a serious burden on the Examiner if restriction is not required. MPEP § 803. Applicants submit that there is no serious burden in combining the restricted groups into one search. A search of the compositions of appetite suppressants of Groups 1, 2 and 3 would also provide search results relating to compositions containing appetite suppressants and compositions containing appetite suppressants in combination with metabolic rate enhancers and nutrient absorption inhibitors, as well as methods of using these compositions. Consequently, would be more efficient for the Examiner to search all of the claims together.

Applicants are required under 35 USC 121 to elect a single disclosed species, i.e., a composition, in each of the six claimed formulations for prosecution on the merits to which the claims will be restricted if no generic claim is finally held to be allowable.

For Group 1 comprising two appetite suppressants, Applicants hereby elect AM 251, a CB-1 inverse agonist, and phentermine as the elected species. The elected species AM 251 is disclosed on page 6 lines 13-18, page 7 lines 1 to 18, and page 61 line 35 to page 62 line 18 of the specification. The elected species phentermine is disclosed on page 9 line 6 to page 11 line 35 of the specification. The following claims read on the composition containing the elected species: 1, 2, 5, 6, 7, 8, 9 and 10.

For Group 2 comprising an appetite suppressant and a metabolic rate enhancer, Applicants hereby elect AM 251, a CB-1 inverse agonist, and L-796568, a β3 agonist, as the elected species. The elected species AM 251 is disclosed on page 6 lines 13-18, page 7 lines 1 to 18, and page 61 line 35 to page 62 line 18 of the specification. The elected species L-796568 is disclosed on page 44 line 29 of the specification. The following claims read on the composition comprising the elected species: 11, 14, 15, 16, 17 and 18.

For Group 3 comprising an appetite suppressant and a nutrient absorption inhibitor, Applicants hereby elect AM 251, a CB-1 inverse agonist, and orlistat, a lipase inhibitor, as the elected species. The elected species AM 251 is disclosed on page 6 lines 13-18, page 7 lines 1 to 18, and page 61 line 35 to page 62 line 18 of the specification. The elected species orlistat is disclosed on page 45, lines 10-13 of the specification. The following claims read on the composition comprising the elected species: 19, 20, 21, 23, 24, and 25.

For Group 4 comprising two metabolic rate enhancers, Applicants hereby elect L-796568, a β3 agonist, and theophylline, a PDE inhibitor, as the elected species. The elected species L-796568 is disclosed on page 44 line 29 of the specification. The elected species theophylline is disclosed on page 44 lines 7 to 9 of the specification. The following claims read on the composition comprising the elected species: 26, 27, 28, 29, 30, 31 and 32.

For composition 5 comprising a metabolic rate enhancer and a nutrient absorption inhibitor, Applicants hereby elect L-796568, a β3 agonist, and orlistat, a lipase inhibitor, as the

elected species. The elected species L-796568 is disclosed on page 44 line 29 of the specification. The elected species orlistat is disclosed on page 45, lines 10-13 of the specification. The following claims read on the composition comprising the elected species: 33, 34, 35, 36, 37, 38, 39 and 40.

For composition 6 comprising two nutrient absorption inhibitors, Applicants have canceled Claims 41-48, which correspond to the Group 6 compositions comprising two nutrient absorption inhibitors.

Applicants make the above elections with the understanding that, if the elected species, i.e. composition, is found to be allowable, the Examiner will examine the genus claims readable thereon and a reasonable number of disclosed species in addition to the elected species.

In light of the above reasons, Applicants respectfully request that the requirement for restriction between Groups 1-6 be withdrawn. In the event that the restriction requirement is made final, Applicants elect Group 1, as indicated above, holding Groups 2, 3, 4, 5 and 6 in abeyance for further prosecution in a divisional application.

Applicants believe that all of the objections and rejections have been overcome by amendment and/or argument, and therefore earnestly solicit an early Notice of Allowance.

Respectfully submitted,

By Baerbel R. Brown

Baerbel R. Brown, Reg. No. 47,449
Attorney for Applicants
MERCK & CO., Inc.
P.O. Box 2000
Rahway, NJ 07065-0907
Tel.: (732)594-0672

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